

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Terence S. Dowling and R. David Arnold Art Unit : 2628
Examiner : Phu K. Nguyen
Patent No. : 7,598,955 Conf. No. : 3536
Issue Date : October 6, 2009
Serial No. : 09/739,587
Filed : December 15, 2000
Title : HINTED STEM PLACEMENT ON HIGH-RESOLUTION PIXEL GRID

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentees hereby request reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 212 days to 219 days is respectfully requested.

REMARKS

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. To the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. § 154(b)(2)(A). As outlined in Wyeth et al. v. Jon W. Dudas (580 F. Supp. 2d 138; 88 USPQ 2d 1538), the only way that these periods of time can “overlap” is if they occur on the same day. If an “A delay” occurs on one calendar day and a “B delay” occurs on another calendar day, they do not overlap and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. Id.

The PTA for the instant patent, as currently calculated and shown on the face of the patent, apparently relies on the premise that the application was delayed under 35 U.S.C. § 154(b)(1)(B) *before* the initial three-year period expired. The Wyeth v. Dudas court determined that this construction cannot be squared with the language of

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35 U.S.C. § 154(b)(1)(B), which applies “if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years.”

“B delay” begins only after the PTO has failed to issue a patent within three years, not before.

Id.

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

“A Delay”

A first PTO action was due on or before February 12, 2002 (the date that is fourteen months after December 15, 2000, the date on which the application was filed). The PTO mailed the first non-final Office Action on March 18, 2003, thereby according a PTO Delay of 396 days. Patentees do not dispute the PTO's calculation for this “A Delay” from February 13, 2002 (the day after the date that is fourteen months after the date on which the application was filed), to March 18, 2003. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

A PTO action was due on or before April 22, 2004 (the date that is four months after December 22, 2003, the date on which a response to Office Action was filed). The PTO mailed a Notice of Allowance on May 17, 2004, thereby according a PTO Delay of 25 days. Patentees do not dispute the PTO's calculation for this “A Delay” from April 23, 2004 (the day after the date that is four months after the date on which a response to Office Action was filed), to May 17, 2004. See 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(2).

A PTO action was due on or before March 22, 2007 (the date that is four months after November 22, 2006, the date on which a response to Office Action was filed). The PTO mailed a non-final Office Action on January 22, 2008, thereby according a PTO Delay of 306 days. Patentees do not dispute the PTO's calculation for this “A Delay” from March 23, 2007 (the day after the date that is four months after the date on which a response to Office Action was filed), to January 22, 2008. See 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(2).

Patent issuance was due on or before June 5, 2009 (the date that is four months after February 5, 2009, the date on which the issue fee was paid). The PTO issued a patent on October 6, 2009, thereby according a PTO Delay of 123 days. Patentees do not dispute the PTO's calculation for this “A Delay” from June 6, 2009 (the day after the date that is four

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months after the date on which the issue fee was paid), to October 6, 2009.

See 37 C.F.R. §§ 1.702(a)(4) and 1.703(a)(6).

In view of the period of “A Delay” detailed above, the total “A Delay” for this patent should be calculated as 850 days (i.e., the sum of 396 days, 25 days, 306 days, and 123 days).

“B Delay”

The period beginning on December 16, 2003 (the day after the date that is three years after December 15, 2000, the date on which the application was filed), and ending October 6, 2009 (the date the patent was issued), is 2122 days in length.

“B Delay” may not include the number of days in the period beginning on the date on which a Request for Continued Examination was filed and ending on the date the patent was issued. In the present application, a Request for Continued Examination was filed on December 22, 2003, and the patent issued on October 6, 2009, resulting in a period of 2115 days that must be excluded from the three year delay calculation.

See 37 C.F.R. §§ 1.702(b)(1) and 1.703(b)(1).

In addition, “B Delay” may not include the number of days in the period beginning on the date on which a Notice of Appeal was filed and ending on the date of mailing of a Notice of Allowance. In the present application, no Notice of Appeal was filed.

See 37 C.F.R. §§ 1.702(b)(4) and 1.703(b)(4).

In view of the periods of “B Delay” detailed above, the total “B Delay” for this patent should be calculated as 7 days (i.e., 2122 days minus 2115 days). The PTO calculated 0 days of delay for issuance of a patent more than three years after filing. Patentees respectfully submit that the PTO's calculation of this “B Delay” is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 7 days. See 37 C.F.R. §§ 1.702(b) and 1.703(b).

Overlap of "A Delay" and "B Delay"

As detailed above, "A Delay" accumulated during the following periods:

February 13, 2002, to March 18, 2003;
April 23, 2004, to May 17, 2004;
March 23, 2007, to January 22, 2008; and
June 6, 2009, to October 6, 2009.

As detailed above, "B Delay" accumulated during the following period:

December 16, 2003, to December 22, 2003.

As such, the periods of "A Delay" and "B Delay" do not overlap (i.e., occur on the same calendar day).

Applicant Delay

The total Applicant Delay for this patent should be calculated as 638 days, as outlined in the Office's "Letter Regarding Patent Term Adjustment," mailed September 2, 2009. Patentees do not dispute the PTO's calculation of Applicant Delay as described therein.

Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

Conclusion

In consideration of the events described above, Patentees believe the PTA calculation of 212 days is incorrect. As such, Patentees respectfully request reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 857 days (i.e., the sum of 850 days of "A Delay" and 7 days of "B Delay");
- 2) Total Applicant Delay should be calculated as 638 days; and
- 3) Total PTA should be calculated as 219 days.

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The fee of \$200 required under 37 C.F.R. § 1.18(e) is being submitted herewith. Please apply any other required charges or credits to Deposit Account No. 06-1050, referencing attorney docket number 07844-0476001.

Respectfully submitted,

Date: December 4, 2009 _____

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